

ESTTA Tracking number: **ESTTA1079361**

Filing date: **09/02/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
Party	Defendant General Cigar Co., Inc.
Correspondence Address	ANDREW DEUTSCH DLA PIPER LLP US 2000 AVENUE OF THE STARS SUITE 400 LOS ANGELES, DE 90067 UNITED STATES Primary Email: Andrew.Deutsch@dlapiper.com Secondary Email(s): David.Huff@dlapiper.com, mkrinsky@rbskl.com, joshua.schwartzman@us.dlapiper.com, john.nading@us.dlapiper.com 212.335.4880
Submission	Stipulated/Consent Motion to Extend
Filer's Name	Andrew Deutsch
Filer's email	Andrew.Deutsch@dlapiper.com, joshua.schwartzman@us.dlapiper.com, john.nading@us.dlapiper.com, valerie.fadis@us.dlapiper.com
Signature	/Andrew Deutsch/
Date	09/02/2020
Attachments	Consent Motion for Extension of Trial Period Deadlines.pdf(20749 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a.
CUBATABACO,

Petitioner,

Cancellation No. 92025859

v.

GENERAL CIGAR CO., INC.,

Respondent.

CONSENT MOTION FOR EXTENSION OF TIME FOR TRIAL PERIOD DEADLINES

Pursuant to 37 C.F.R. §§ 2.121, 2.123(c) and TBMP §§ 501, 509, 701 and 703, Respondent General Cigar Co., Inc. (“Respondent” or “Defendant”), together with Petitioner Empresa Cubana del Tabaco d.b.a. Cubatabaco (“Petitioner” or “Plaintiff”) (Respondent and Petitioner, collectively, the “Parties”), jointly request an extension of the pending trial deadlines for the reasons set forth in this Consent Motion.

1. Proceedings were suspended by Order dated January 29, 2020, to permit the U.S. Trademark Trial and Appeal Board (“Board”) to rule on a Motion by Petitioner (243 TTABVUE 2). On August 26, 2020, the Board entered an Order, which resumed proceedings and re-set the case deadlines. (250 TTABVUE 14-15.). The deadline for the close of Respondent’s trial period,

is currently set for September 15, 2020; Petitioner's Pretrial Rebuttal Disclosures are currently due on September 30, 2020 and its Rebuttal Period currently ends on October 30, 2020. *Id.*

2. However, during the suspension and prior to the Board's issuance of its August 26 2020 Order, counsel for both Petitioner and Respondent have been made subject to court-ordered commitments in federal District Court actions in other courts, that make compliance with the deadlines set in the August 26, 2020 Order for this TTAB cancellation proceeding exceedingly difficult and unduly onerous, difficulties and burdens exacerbated even further by the on-gong COVID-19 pandemic.

3. On Respondent's counsel's side, Joshua Schwartzman, who is substantially responsible for preparing and assembling Respondent's trial evidence, is also the lead associate on *Chicago Mercantile Exchange Inc. v. ICE Clear US, Inc., et al.*, Case No. 18-C-1376, a case which was ordered to immediate trial in the United States District Court for the Northern District of Illinois, beginning this Monday, August 31, 2020, and continuing over the course of the next several weeks. As a result, Mr. Schwartzman is not available to handle this matter for most, if not all, of the time between now and September 15, 2020 (the current close of Respondent's Trial Period), thereby significantly impeding Respondent's preparation and submission of its trial evidence.

4. Further, Respondent's counsel are not able to access their offices on a regular basis and must work remotely on account of the ongoing COVID-19 situation. Respondent's trial evidence, including many documents to be filed under notice of reliance, are currently in hard copy at the offices and Respondent's counsel will have only time-limited access to those offices during the month of September 2020.

5. For this reason, the parties move the Board to extend the close of Respondent's trial period by two weeks, to September 29, 2020.

6. Petitioner has consented to Respondent's request, on the basis that Petitioner's schedule be adjusted, as described below, because of its counsel's court-ordered commitments in a federal District Court action in another court, as well as the difficulties created by the COVID-19 pandemic.

7. As to Petitioner's counsel:

During its trial period, Respondent anticipates filing trial testimony by declaration for at least three (3) fact witnesses and one (1) expert witness. Under the Rules, Petitioner would have twenty (20) days to notice its election to orally cross-examine these witnesses and then thirty (30) days to complete those depositions, during which time the Board would suspend proceedings to allow for the orderly completion of the oral cross-examinations. 37 C.F.R. § 2.123(c); TBMP 703.01(e).

Petitioner's counsel, Michael Krinsky and Lindsey Frank, of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. ("RBSKL"), are counsel to the three defendants – two entities organized under the laws of the Republic of Cuba and one entity organized under the laws of the Panama – in *Exxon Mobil Corp. v. Corporación CIMEX, S.A. (Cuba), Corporación CIMEX, S.A. (Panama) and Unión Cuba-Petróleo*, Case No. 19-cv-1277-APM, a federal action in the United States District Court for the District of Columbia. Under the court ordered schedule, the defendants in that case filed a Motion to Dismiss Action With Prejudice, and For Other Relief, on June 16, 2020 raising numerous fact and legal issues under the Foreign Sovereign Immunities Act, public international law and the Due Process Clause. In support, Defendants filed eight (8) fact declarations and two (2) expert declarations. On July 13, 2020, the District Court, recognizing the scope and complexity of the presented issues, entered an order providing for fifteen (15) weeks for

Plaintiff Exxon Mobil to respond to Defendants' motion, and set forty-five (45) days for the Defendants to reply.

Under this court-ordered schedule, counsel for Petitioner here will need to devote themselves fully to preparation of the Defendants' papers in *Exxon Mobil* between September 29, when Exxon Mobil will file its opposition papers, and November 13, 2020, when Defendants' reply papers are due. Under the present TTAB set schedule, this would be the period that Petitioner would have to orally cross-examine Respondent's witnesses and prepare and submit its rebuttal case. Counsel for Petitioner would therefore be significantly impeded in its preparation for and cross-examination of Respondent's fact witnesses and expert witness and its preparation and submission of its rebuttal case, and would suffer an undue burden.

8. Further, on account of the ongoing COVID-19 pandemic, Petitioner's counsel, like Respondent's, is not able to access its office on a regular basis and must work remotely. Many of Petitioner's trial materials, including many documents it would need to prepare for cross-examination of Respondent's fact and expert witnesses and documents it would need to prepare its rebuttal case, are currently in hard copy at Petitioner's office and Petitioner's counsel will have only time-limited access to its office for the foreseeable future.

9. For these reasons, the parties move the Board to extend the time: for Petitioner to complete oral cross-examination of Defendant's witnesses whose testimony is submitted by affidavit or declaration to December 18, 2020; for Petitioner to submit its Rebuttal Disclosures to January 16, 2021; and of the close of Petitioner's Rebuttal Period to February 15, 2021.

10. Finally, both Petitioner and Respondent believe that additional time is necessary for preparation of their trial briefs. The record in this proceeding includes a large evidentiary record from discovery in this proceeding as well as evidence from a prior federal court civil trademark

infringement litigation between the Parties, numerous trial witnesses, and further, numerous grounds for cancellation have been asserted by Petitioner in its Amended Petition (61 TTABVUE), all of which must be addressed in the trial briefs. The parties believe that given the circumstances, adequate briefing requires that Petitioner have three months, instead of two, from the close of its rebuttal period, to submit its trial brief, that Respondent have two months, instead of one, to submit its own brief, and Petitioner have forty-five, instead of fifteen, days to submit its reply brief. For these reasons, the parties move the Board to extend the time for Petitioner to submit its trial brief to May 17, 2021, for Respondent to submit its brief to July 17, 2021, and for Petitioner to submit its reply brief to September 2, 2021.

11. For all of the foregoing reasons, the Parties jointly move to extend the schedule as follows:

Defendant's Trial Period Ends	September 29, 2020
Last day for the completion of oral cross-examination of Defendant's witnesses whose testimony is submitted by affidavit or declaration	December 18, 2020
Plaintiff's Rebuttal Disclosures Due	January 16, 2021
Plaintiff's Rebuttal Period Ends	February 15, 2021
Plaintiff's Opening Brief Due	May 17, 2021
Defendant's Brief Due	July 17, 2021
Plaintiff's Reply Brief Due	September 2, 2021
Request for Oral Hearing (optional) Due	September 12, 2021

WHEREFORE, for good cause shown, the Parties respectfully request that this joint Consent Motion be granted.

Dated: September 2, 2020

DLA Piper LLP (US)

By: /s/ Andrew L. Deutsch
Andrew L. Deutsch
DLA PIPER LLP (US)
2000 Avenue of the Stars
Suite 400, North Tower
Los Angeles, California 90067-4704
Telephone: (310) 595-3000
Facsimile: (310) 595-3300
andrew.deutsch@us.dlapiper.com

Joshua Schwartzman
DLA PIPER LLP (US)
1251 Avenue of the Americas
New York, New York 10020-1104
Telephone: (212) 335-4500
Facsimile: (212) 335-4501
joshua.schwartzman@us.dlapiper.com

John M. Nading
DLA PIPER LLP (US)
500 Eighth Street, N.W.
Washington, D.C. 20004
Telephone: (202) 799-4000
Facsimile: (202) 799-5000
john.nading@us.dlapiper.com

*Attorneys for Respondent
General Cigar Co., Inc.*

Dated: September 2, 2020

Rabinowitz, Boudin, Standard, Krinsky &
Lieberman, P.C.

By: /s/ Lindsey Frank
Michael R. Krinsky
Lindsey Frank
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.
14 Wall Street, Suite 3002
New York, New York 10005
Telephone: (212) 254-1111
mkrinsky@rbskl.com
lfrank@rbskl.com

Attorneys for Petitioner
Empresa Cubana del Tabaco d.b.a. Cubatabaco

CERTIFICATE OF SERVICE

I hereby certify that on this date I have caused to be served a true and correct copy of the foregoing **CONSENT MOTION FOR EXTENSION OF TRIAL PERIOD DEADLINES** by transmitting copies by email to Petitioner's counsel:

Michael R. Krinsky
Lindsey Frank
Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C.
14 Wall Street, Suite 3002
New York, NY 10005
mkrinsky@rbskl.com
lfrank@rbskl.com

Attorneys for Petitioner
Empresa Cubana del Tabaco d.b.a. Cubatabaco

Date: September 2, 2020

/s/ Andrew L. Deutsch
Andrew L. Deutsch
Attorney for Respondent
General Cigar Co., Inc.